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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,060	08/17/2001	Joseph Gubernick	2870/536	5059
7590 02/23/2006			EXAMINER	
Karen A Lowney Esq Estee Lauder Companies 125 Pinelawn Road Melville, NY 11747			DOAN, ROBYN KIEU	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/932,060

Applicant(s)

GUBERNICK, JOSEPH

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 29 is/are allowed.  
6) ☒ Claim(s) 1-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn and a new final rejection is applied herewith.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6-7, 11-12, 15 and 17-19 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Israel et al.

With regard to claims 1-2, Israel et al discloses a case (figs. 1-2) comprising a surface (28) having one or more grooves (recess 26 fig. 1), openings toward the tops of one or more grooves and at least one cosmetic powder (40) disposing in the groove. The method used to form the powders by extruding is given no patentable weight. In regard to claims 6-7, the grooves being integrally made with the surface (28), the method used to form the grooves by molding with the surface or by cutting into the surface is given no patentable weight. In regard to claims 11-12, Israel et al shows one of the grooves being closed at both ends (at 26 fig. 1) and one divider (top surface 28

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between groove 24 and groove 26) adapting to separate the extruded powders. In regard to claims 15, 17-19, the cross sectional shape of each groove matching the cross sectional shape of the extruded powders, wherein the cross sectional shape of the grooves being rectangular (fig. 1); the case further having a surface comprising a section without grooves (at 22), this section holding a mirror (22). In regard to claims 26-28, the case also having a cover (14) being hinged to the surface.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al.

With regard to claims 10 and 16, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for one or more grooves being opened at one or more ends of the grooves and the cross sectional shapes of the grooves being not all the same. It would have been an obvious matter of design choice to construct the one or more grooves being opened at one or more ends of the grooves and the cross sectional shapes of the grooves being not all the same, since such modifications would have involved a mere change in the shape of the components.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al in view of von Kleinsorgen.

With regard to claims 3-5, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for the powders being not all the same color and chemical composition and forty percent or more of each powder rises above the surface. Von Kleinsorgen discloses a cosmetic stick (fig. 1) comprising at least two powders (12, 13) being not all the same color and chemical composition (col. 4, lines 19-22) and wherein the powder of each chemical composition being arranged in section (fig. 1), each section holding one chemical composition. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality different colors.

Claims 8-9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al in view of Schefer.

With regard to claims 13-14, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for a portion of the powders or forty percent or more of the powders rises above the surface, one or more restraints that inhibiting the powders from coming out of the grooves and wherein the grooves openings being slightly smaller than the extruded powders. Schefer discloses a cosmetic compact case (fig. 6) comprising a surface (30) having a plurality of grooves, a

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portion of cosmetic powder (24) rises above the surface (fig. 6), the case further having one restraint (22). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the restraint as taught by Schefer into the case of Israel et al for the purpose of inhibiting the powders from coming out of the grooves and it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct wherein the grooves openings being slightly smaller than the powders, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art and it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct forty percent or more of each powder rises above the surface, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel in view of Gueret.

With regard to claims 20-25, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for an outer container having a section holding a mirror and a cover being hinged to the outer container. Gueret discloses a cosmetic compact case (fig. 1) comprising an outer container (1) having a cover (c) being hinged to the container (13) and a mirror (14). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to

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employ the outer container as taught by Gueret into the case of Israel et al for the reusable purpose.

Claim 29 is allowable over prior art.

With regard to the arguments about the differences of the final product between extruded powder and pressed powder, the actual pages of the Handbook of Powder Science and Technology have been considered and acknowledged; however, as addressed in an earlier office action mailed on 12/17/03, Applicant must submit evidences to support the arguments in ALL CASES not just a single reference, such as the Handbook of Powder Science and Technology, which shows the differences of the final product between extruded powder and pressed powder, therefore, the arguments are not persuasive.

Second, Applicant has argued about the tensile strength and the orders of magnitude difference in the tensile strength of the extruded powder, however, a person in an ordinary skill in the art cannot recognize the difference because it is unclear what kind or how much of tensile strength that applicant try to imply. Also, since the claims in the instant application are very broad and do not include any strength, the prior art meets the claimed limitations.

Finally, Applicant has argued the criticality of the tensile strength, however, such criticality is not disclosed in the original disclosure, therefore, the criticality of the tensile strength is given no patentable weight.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

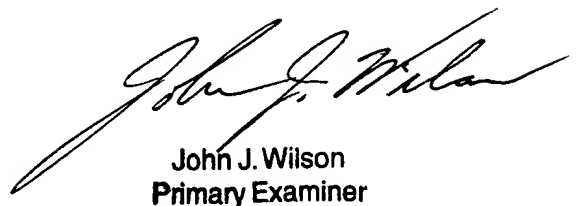


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan  
Examiner  
Art Unit 3732



John J. Wilson  
Primary Examiner